

In The United States Patent And Trademark Office. Before the Trademark Trial and Appeal Board

In re registration of

Registration #: 4164,790

Mark: Adam Loophole Presents Rot Apparel

Registration Date: June 26 2012

Republic of Texas Biker Rally, Inc: Petitioner

Vs

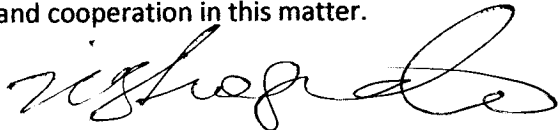
Peter C. Ogudo, Registrant/ Respondent

Cancellation # 92056510

# 76701933

Statement Of Good Cause

My name is Peter Ogudo, Registrant/ Respondent in this matter. My prior answer to petitioner's cancellation proceedings did not meet the Standard Procedural requirement for an answer. After having received sufficient tips and technical help on how to proceed, I promise that future correspondence with this board will properly follow the rules of practice and procedure. I am in the final stage of vetting a list of potential trademark attorneys from which to pick one that would handle this case moving forward. Granted, my technical knowledge of TTAB affairs are faint and nothing to write home about, I'm sincerely requesting that I be granted and allowed permission to refile an answer that will correspondingly adhere to each of the petitioner's allegation. Thank you again for your understanding and cooperation in this matter.



Peter Ogudo, Registrant/Respondent

Registrant/Respondent's Answer To Petitioner's Petition For Cancellation

1. Registrant/Respondent, Adam Loophole Presents Rot Apparel, registration # 4164,790 denies damaging petitioners mark, known as Republic of Texas Biker Rally, and hereby urges this board to deny cancellation request. Registrant /Respondent maintains in its defense that petitioner's mark, viz Republic of Texas Bikers Rally Inc is wholly different in name and meaning from Registrant/ Respondent's mark, viz Adam Loophole Presents Rot Apparel
2. Registrant/Respondent admits that its current address remains at Po box 2574 Culver City, CA 90231
3. Registrant/Respondent admits to having filed on March 5<sup>th</sup> 2010 an intent to use application, serial #76/701933, to register the mark Adam Loophole Presents Rot Apparel ("the loophole mark") for use with clothing, namely t-shirts, vests, slacks, hooded sweatshirt, jackets, hats, footwear, shoes, sneakers, sandals, caprice, socks, slippers, jeans, under garments, blouses,



\*08-08-2013\*

- dresses, suits, pant suits, coats, pants, belts in international class 25 and for handbags, backpacks, purses, wallets, tote bags, travel bags, and carryon bags in international class 18.
4. Registrant/Respondent admits to having filed on March 15<sup>th</sup>, 2012, a statement of use alleging 1<sup>st</sup> use of mark on August 28<sup>th</sup>, 2008. Registrant/Respondent admits to attaching thereto, specimens of use consisting of a t-shirt, a tote bag, & two labels. Registrant/Respondent also admits to being issued May 25<sup>th</sup> 2012 a notice of acceptance of statement of use by the USPTO. Based upon Registrant/Respondent having fulfilled all prior requirements for registration of a trademark, viz initial application and payment of a fee, due diligent searches by USPTO trademark attorneys; and finally a lack of conflicting names; hence the above trademark Adam Loophole Presents Rot Apparel was granted Registrant/Respondent.
  5. Registrant/Respondent again admits that after having fulfilled all prerequisites for registration, the loophole mark was registered on June 26<sup>th</sup>, 2012
  6. Registrant/Respondent also admits to production of & merchandizing of Loophole Products prior to 6/26/12, but not "modest amount of goods," as alleged by Petitioner. Registrant/Respondent avers that its clientele strength is not "geographically limited", but rather a main stream clientele that is hard to be geographically pigeon holed.
  7. Registrant/ Respondent deny its sales of goods, which bear the Loophole mark was at most "in limited or minimal quantities." Registrant/Respondent avers that its sales quantity is in the mid to high quantity classification range.
  8. Registrant/Respondent denies sufficient knowledge of petitioner's ownership of & filings for petitioner's Rot registration prior to inception of this case, including all of Rot Rally, Rot Biker Rally, R.O.T. Rally, & R.O.T. Biker Rally. Registrant/Respondent first contact with and/or knowledge of petitioner and his Rot registration came at time of receipt of application for cancellation. Registrant/Respondent, however at time of conducting basic TESS search of Adam loophole Presents Rot Apparel found nothing that conflicts with its search, and thus applied for registration with USPTO.
  9. Registrant/Respondent denies sufficient knowledge of petitioner's alleged prior filings of its Rot registrations and also denies knowledge of Rot registration prior use. Registrant/Respondent, again avers that at time of its TESS search on USPTO no such conflicting registration showed up on TESS search results as to alert a red flag conflict of names. Registrant/Respondent therefore went ahead and applied for and was granted registration of Adam Loophole Presents Rot Apparel.
  10. Registrant/Respondent denies any sufficient knowledge of petitioner's alleged ownership of pending US trademark application for "ROT" marks. Registrant/Respondent avers that it is not in the business of monitoring pending trademark applications for petitioner. Registrant/Respondent after being successfully granted registration of Adam Loophole Presents Rot Apparel stayed focused on production and manufacture of its line of apparel clothing for its mainstream clientele, including casual wear and accessories.
  11. Registrant/Respondent denies sufficient knowledge of petitioner's use of ROT marks prior to respondent's filings of the Loophole mark. Like Registrant/Respondent has averred in one of the preceding paragraphs, the petitioners ROT marks never showed up in the USPTO's TESS search when Adam Loophole Presents Rot Apparel was keyed in for a search.

12. Registrant/Respondent denies sufficient knowledge of petitioner's alleged prior ROT marks and potential Rot applications which petitioner referred to as ROT marks, up until this case was file.
13. Registrant/Respondent denies sufficient knowledge of petitioner's alleged prior use of ROT marks as claimed by petitioner dating back to 1999 up until this case for cancellation was filed, as well as in connection with goods and services.
14. Registrant/Respondent denies sufficient knowledge of petitioner's alleged use of Rot marks being valid and continuous since their date of 1<sup>st</sup> use. Registrant/Respondent has no prior knowledge of petitioner's affairs or name until these cancellation proceedings resumed.
15. Registrant/Respondent denies sufficient knowledge of petitioner's alleged prior use of Rot marks and petitioner's potential applications allegedly pre-dating Respondent's 1<sup>st</sup> use of an application for Loophole mark. Registrant/Respondent also denies petitioner's alleged claim of priority over the Loophole mark. Denial is founded on the basis that both marks are different in name and meaning; and therefore claim of priority is moot and preposterous.
16. Registrant/Respondent denies sufficient knowledge of petitioner's representative products allegedly existing prior to Registrant/Respondent's products and services.  
Registrant/Respondent's products, per se, just do not have one word "Rot" tag line forming the basis for product placement and visibility. Registrant/Respondent's products instead have series of prefixed word tag lines surrounding the word "Rot". For example, Adam Loophole Presents Rot Apparel is made of 5 words all expressing a name that presents an apparel line. Registrant / Respondent, therefore denies that petitioner's six products offered on page six of pleadings with the word "Rot" embossed on each, have any bearing with or relationship to following Registrant/Respondent's 5 worded trademark, to wit: Adam Loophole Presents Rot Apparel.
17. Registrant/Respondent denies any knowledge of petitioner's Rot marks alleged extensive goodwill and recognition; and also denies knowledge of how much petitioner spent on promotion and advertising. Registrant /Respondent's first knowledge of petitioner's name actually came to fore when this pleading was served.
18. Registrant/Respondent denies that Loophole mark is similar to Rot marks, whether substantially or phonetically. Registrant/Respondent avers that when Adam Loophole Presents Rot Apparel was searched for on USPTO's basic TESS field, what appeared was a "no match" result indicating a lack of potential conflict of trademarks contrary to what was searched for.  
Registrant/Respondent therefore upon reasonable belief and trustworthiness of USPTO search system, then applied for the Loophole mark; and hence was granted Adam Loophole Presents Rot Apparel.
19. Registrant/Respondent admits that the goods bearing both marks are identical; namely clothing and clothing accessories. Registrant/Respondent however avers that the marks appearing on same goods and accessories are contrasting in name, symbols, and phonetics.
20. Registrant/Respondent admits that both Loophole marks and Rot mark products are offered for sale and sold through similar, but not same, channel. Registrant/Respondent, however, denies both Loophole and Rot mark product are sold to same class of purchasers. Upon information and belief, petitioner's goods bearing Rot marks are sold to motorcyclists during the yearly June Biker Rally. Registrant/Respondent however avers that Loophole products are not rider or class specific, but rather sold to all comers, especially the hip urban clientele.

Count 1- Denial to likelihood of confusion

21. Registrant/Respondent hereby incorporates by reference the preceding denials and admissions.
22. Registrant/Respondent, upon reasonable belief, denies knowledge of petitioner's alleged use of Rot marks prior to date of filing for and first use of Loophole marks. Registrant/Respondent avers that prior to application for and registration of Loophole mark, it conducted the USPTO basic test search of Adam Loophole Presents Rot Apparel, and which search, finally turned up a "no match" result.
23. Registrant/Respondent denies petitioners claimed validity of Rot registrations as subsisting and, and therefore a prima facie evidence of exclusivity of use of Rot marks in commerce. When Registrant/Respondent first applied for Loophole marks, no such exclusivity was disclosed to Registrant/Respondent by the trademark attorney handling the applications for registration. At the time of application for registration, however the Registrant/Respondent received an office action letter that said there was no match or conflict for the Loophole mark. Subsequently, the application was granted.
24. Registrant/Respondent denies prior knowledge of petitioner's alleged July 11<sup>th</sup>, 2011 final judgment of United District Court for the Western District of Texas (Austin Division) involving petitioner and an unnamed litigant. Petitioner alleges the court's findings and determination in ownership in the marks: ROT Rally, R.O.T. Rally, ROT Biker Rally and R.O.T. Biker Rally. Petitioner also alleges as part of findings of court, that each of above marks is valid, enforceable, and famous within the meaning of 15. U.S.C. 1125 (C) and have each become distinctive of petitioners goods and services. Registrant/Respondent, however, again merely applied for a five worded trademark beginning with "Adam" and ending with "Apparel", to wit; "Adam Loophole Presents Rot Apparel". Subsequently, Registrant/Respondent was granted registration # 4164790, dated 06/26/2012 for the Loophole mark, and from that moment on, the respondent's goods and services is distinctive of Loophole marks within the meaning of 15. U.S.C. 1125 (C).
25. Registrant/Respondent denies prior knowledge of USPTO's office action dated September 6<sup>th</sup>, 2012 as alleged by petitioner stating, " that a likelihood of confusion existed in class 25 and 26 between petitioners Rot mark and Registrant/Respondent Loophole mark."  
Registrant/Respondent also denies the alleged office action opinion of "creating an impression of presentation of an apparel line Rot," for that has never been the intention of the Loophole mark from the get go. Registrant/Respondent, rather uses the whole 5-worded tag line comprising the whole essence of the Loophole mark, to wit; Adam Loophole Presents Rot Apparel for sole purpose of identification of its products and services. For to obviate any one word or series of words from its intended meaning will defeat the overall collective intent, meaning and essence of the Loophole mark. Registrant /Respondent also deny petitioner's marks lack distinct commercial impression as to contain same common wordings as Loophole mark. Registrant/Respondent refers this board to all of petitioner's marks which contain wordings distinguishing motorcycles and bikers rallying together as the main stay of petitioner's

business. Registrant/Respondent's Loophole mark, however lacks any of motorcycles and bikers foundation, and therefore dissimilar to petitioners type of clientele.

26. Registrant/Respondent again denies prior knowledge of USPTO's office action dated September 28<sup>th</sup>, 2012, as alleged by petitioner stating, " that a likelihood of confusion existed in class 25 and 26 between petitioner's Rot marks and Registrant/Respondent's Loophole mark." Same denials and factual statements and averments as in paragraphs 25 apply. Registrant/Respondent also denies both marks sound alike and therefore confusingly similar. When Registrant/Respondent applied for the Loophole mark and was granted its registration, literary elements were bypassed, such as sounds, phrases, pictures and symbols. The look and feel of its products and services were ingrained in its consumers as to know and appreciate where the products came from. Qualities such as look, the meaning, the wordings, the prefixes and suffixes, phrases, pictures, logos, and the symbol all collectively distinguished the Loophole mark from any potential conflict with another. Registrant/Respondent in denying petitioners claimed significant effect of USPTO office action, however refers the TTAB to the following case that is contrary to the position of the alleged office action. In *B&B Hardware, Inc V. Hargis Industries* 2013 WL 1810614, 2013 US APP Lexis 8926 (8<sup>th</sup> Circuit May 1<sup>st</sup>, 2013) "...the factors the TTAB considers for trademark registration purposes differed from the factors considered under the 8<sup>th</sup> circuit likelihood of confusion tests for trademark infringement. In particular a TTAB test places greater emphasis on appearance and sound of the marks, while the 8<sup>th</sup> circuit test places greater emphasis on marketplace usage of the marks and products" (Kaye Scholer, intellectual property attorney, in "Emerging trends: 8<sup>th</sup> circuit holds that TTAB determination of likelihood of confusion is not binding on subsequent infringement action"). In essence, Registrant/Respondent therefore denies the effect of petitioners alleged USPTO September 28, 2012 office action opinion as controlling and trend setting. Registrant/Respondent in referencing the above case, ..... The US Court of Appeals for the 8<sup>th</sup> circuit held that a trademark trial and appeal board's (TTAB) decision on likelihood of confusion was not entitled to preclusive effect in a federal trademark infringement action, and that it was not an abuse of discretion for a district court to reject admission of the TTAB decision into evidence.
27. Registrant/Respondent therefore accordingly denies any identity of goods and services both of petitioners and respondents; and also denies any likelihood of confusion of both marks and their goods and services. Registrant/Respondent also denies any establishment of prima facie case for cancellation of the Loophole mark. Registrant/Respondent instead sees a contrary lack of proof of similarity; lack of proof of adequate and sufficient evidence; and also material issue of fact does not exist. Registrant/Respondent therefore is entitled to judgment as a matter of law. And, or alternatively deny cancellation and dismiss this frivolous case.
28. Registrant/Respondent denies prior knowledge of petitioners alleged 2009 Rot filings and registration for goods and services in class 25 and 26. Registrant/Respondent at the time of applying for Loophole mark only applied for international classes 18 and 25 and then also lack knowledge of and reason to know of Rot Rally or Rot Biker Rally whose mainstay, upon information and belief, was Biker gatherings covering sales of t-shirts, patches, pins and belt buckles for riders.

29. Registrant/Respondent therefore denies petitioners alleged claim of likelihood of confusion between petitioners and respondents products and services. Petitioners claimed pre existing Rot marks or registrations all tend to be "Rally" or "Biker" related and are, therefore, geared to that crowd namely motorcyclists and riders. On the other hand, respondents Loophole marks are geared towards Hip-Hop, urban consumers, the super majority of whom are non riders. Accordingly, respondent denies any likelihood of confusion between the two products and services and hence establishes a case for denial of cancellation and dismissal of this frivolous case.
30. In conclusion, Registrant/Respondent denies similarity of the two products and services or identity of channels of trade and any claimed confusion, mistake or deception as to sources of the two products and services. Registrant/Respondent operates under a trade name different and dissimilar from petitioners. Furthermore, respondent's goods and services are not sold and displayed in annual motorcycle rallies, but instead are sold in regular urban Hip-Hop stores. Additionally, respondent's clientele have the ability to distinguish its products and services from others; and same logic applies to petitioner's motorcycle enthusiast clientele. Registrant/Respondent denies prior knowledge of petitioner's products and ridership fraternity and also has no reason to know of it except at very inception of these proceedings. Therefore, petitioner's claimed passing off has no basis in fact or in law because respondent's "Rot Apparel" stands for "rule of thumb", whereas petitioners "Rot Rally" stands for "republic of Texas"

#### Count 11: Denial to Petitioner's Claim of Dilution

31. Registrant/Respondent hereby incorporates by reference the preceding denials to petitioner's allegations.
32. Registrant/Respondent denies prior knowledge of petitioners ROT marks and alleged claim to it of being famous. Respondent searched on, and applied for Adam Loophole Presents Rot Apparel, and after fulfilling all of the statutory requirements, including conflict with existing trade names and trademarks, was granted registration # 4164790 for above named mark that has no bearing to or semblance with ROT Rally or ROT Biker.
33. In light of Registrant/Respondent denials of claim of similarity as alleged by petitioner, and by extension preposterous and dubious claim of resemblance, dilution, blurring or tarnishment, petitioner, therefore has not established its case as a matter of fact and law. Petitioner has merely based his claim to mere office action that is not overriding and controlling (please see B&B Hardware, Inc vs. Hargis Industry above). Additionally, Registrant/Respondent has proffered information establishing that ROT Biker Rally caters to motorcyclists, while respondent's products cater to non rider Hip-Hop urban customers. Included in the information is the fact that both products take different channels. One is hawked in Biker convention centers and kiosks; the other is hawked in Hip-Hop stores in urban neighborhoods.

#### Count 1- Defenses to likelihood of confusion

1. Registrant/Respondent hereby incorporates by reference the preceding denials to petitioner's allegations; together with the following defenses to likelihood of confusion.
2. Lack of relatedness of goods and services for both marks S. 1207. 01 (a)
3. Lack of identity of both marks 1207. 01
4. Both marks serve different clientele; viz Bikers for petitioner and Hip-Hop clientele for respondent.
5. Dissimilarity of both competing marks in the stream of commerce 1207. 01 (b)
6. Differentiation of contextual word marks for both marks 1207. 01 (b) (i)
7. Dissimilarity of both marks in appearance 1207. 01 (b)(ii)
8. Dissimilarity in sound for both marks 1207. 01 (b)(iv)
9. Dissimilarity in meaning for both marks 1207. 01 (b)(v)
10. Dissimilarity of both marks in multiple wordings associated with respective marks 1207. 01 (b)(viii)
11. Dissimilarity of designs for both marks 1207. 01 (c)
12. Resolution of doubts as to similarity should be resolved in respondent's favor 1207. 01 (d)(i)
13. Petitioner's failure to prove actual confusion, not just likelihood of confusion 1207. 01 (d)(ii)
14. Prior decisions of examining attorneys have approved other "ROT" related trademarks 1207. 01 (d)(vi)

#### Count 2- Defenses to Dilution

1. Registrant/Respondent hereby incorporates by reference the preceding denials to petitioners allegation of dilution; together with the following defenses to dilution
2. No protection for distinctiveness

Dilution does not protect descriptive marks since they possess no inherent distinctive quality, ROT is inherently deficient in distinctiveness and is not compensated by fact mark is known by just riders and bikers. "ROT biker" or "ROT Rally", merely describe a rally or gathering of like minded motorcycle aficionados.

3. Non commercial use

Registrant/Respondent has never at any time in the past or presently projected or produced goods or services bearing petitioners "ROT Biker" or "ROT rally" logos. Respondent, instead has used its legitimately approved trademark name on its goods and services; to wit: "Adam Loophole Presents Rot Apparel"

4. Requirement of both fame and distinctiveness

Some famous marks with common names as American, National, federated, ROT, first, federated, merit or the like are not allowed by statute to exclude all new entrants. Therefore, petitioner has not proved separate distinctiveness to obtain relief.

5. Lack of showing of actual dilution

Petitioner has failed to show "actual, consummated harm." There's a complete absence of evidence in the record of any lessening of the capacity of ROT Bikes marks to identity, and distinguish goods or service sold by ROT Bikers. Petitioner has just relied on merely likelihood of dilution without going any further than that. See *Moseley v. v. Secret Catalogue* 537 US 418 2003

Therefore, Registrant/Respondent denies that its goods and services are in any manner or form damaging to petitioners and accordingly prays this board to dismiss the petition to cancel.

Each clientele of the parties are material and should be able to distinguish both products from each other. Both marks are visually and phonetically distinguishable and create divergent impressions. A reasonable person would not consider the marks confusingly similar. Respondent has also established due diligence search prior to being granted registration by examining attorneys of USPTO. One mark is "Republic of Texas" the other is "Rule of thumb". One party is claiming sole possession of a word; the other party is heading in opposite direction. In view of the foregoing, the petitioner has not met the burden of proof of similarity and dilution and passing off as erroneously alleged in the pleadings.

Respectfully submitted,

Peter Ogudo, in pro per

By 

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Dated 8/5/13

Certificate of service

I hereby certify that on 8/5<sup>th</sup> 2013, I served this answer to petition for cancellation by mailing a copy thereof by registered mail, return receipt registered, addressed to petitioner's attorney's office of record as follows:

Carl f. Schwenker

Law offices of Carl Schwenker

1101 east 11<sup>th</sup> Str.

Austin, TX 78702

By 

Peter Ogudo